

REMARKS

Claims 1-11 and 21-27 are currently pending upon entry of the above amendment. The above-requested amendment to the specification is merely editorial in nature, and it does not raise any new issues requiring further consideration or search by the Patent Office. Therefore, the amendment is considered appropriate for entry at this time.

At pages 2-3, paragraph 19, of the final Office Action, it is urged that Applicants have not responded to an objection of record regarding the need for a generic description to accompany a trade mark "FM-300" mentioned at page 6, line 25 of the application.

In response, Applicants respectfully submit that the content of the instant specification, at page 6, line 28 to page 7, line 2, and especially as editorially amended above, provides an adequate generic description accompanying the composite carrier film backing exemplified as "FM-300". Namely, the specification explains that composite carrier film of this trade name has an overall thickness of 13 mil comprised of an open knit polyester scrim that is 8 mil thick and a continuous epoxy resin surface layer. Again, Applicants have made editorial amendments at page 6, line 28, which more specifically identify the generic description that was originally provided to accompany the mention of the FM-300 composite carrier film backing. Therefore, Applicants respectfully submit that this objection is no longer applicable, and it can be withdrawn.

At page 3, paragraph 20, of the final Office Action, claims 1 and 8-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,364,705 to Callahan (Callahan '705).

The final Office Action (p. 3) is understood to maintain the rejection of record in this regard, and insofar as the new claim recitations added in Applicant's response dated August 7, 2000, the final Office Action states the following:

... Applicant's arguments regarding the new limitations of "curable adhesive material being co-curable with the curable resin" have been considered but this is not a positive limitation but only requires the ability to so perform since it is similar to "capable of" language and implication. This new limitation does not constitute a limitation in a patentable sense, In re Hutchinson, 69 USPQ 138. Regarding the limitations of claims 10 and 11 with conductive ink and magnetic particles, '705 does describe "conductive ink layer" which generically encompasses the species of conductive ink and magnetic particles claimed. Claims lack novelty.

Applicants point out that instant claim 1 recites:

A screen ink printed film carrier, comprising a thin film carrier layer supporting an ink pattern containing an electrically resistive or conductive material and a curable resin, wherein said thin film carrier layer comprises a curable adhesive material in contact with said ink pattern, and the curable adhesive material being co-curable with the curable resin. [Applicants' underlining added for emphasis]

The Final Office Action does not appear to disagree with Applicants' observation of record that Callahan '705 fails to teach a screen printed ink pattern as claimed as being supported by a thin film carrier layer comprises a curable adhesive material in contact with said ink pattern, in which the recited adhesive material of the thin film carrier layer is co-curable with the curable resin of the ink pattern.

As previously explained in the record, Callahan '705 only teach supports for the silk screened patterns which are either stiff plastics that are either not curable or no longer curable, such as kapton, polyester, or polyimide, or quartz glass or S-glass substrates on the other hand (see col. 5, lines 20-26; col. 2, lines 27-29).

Nonetheless, the final Office Action is understood to disregard this recited difference from Callahan '705. Namely, the Examiner is understood to take the position that Applicants' claim limitation of "... curable adhesive material being co-curable with the curable resin" (emphasis added by underlining) is not a positive claim limitation and essentially is "capable of" type language not accorded patentable weight. The Examiner relies on In re Hutchison, 69 USPQ 138, as authority for his position in this regard.

Even assuming Hutchison is a relevant legal authority (a proposition which Applicant's respectfully disagree with for reasons that will be explained below), Applicants first note that facts critical to the Court's decision in Hutchison are not on all fours with the current situation. Namely, Hutchison concerns a statement in an introductory clause or preamble that an article is "adapted" for a specific intended or preferred use. By

contrast, the present claims concern the inherent or intrinsic properties of two components (i.e., the curable adhesive material and the curable resin are co-curable) of the claimed screen ink printed film carrier as recited *in the body of the claim*.

The "co-curable" language recited in the instant claims is not merely intended use or intended purpose language recited in a preamble, but instead constitutes an actual structural and functional feature of the invention as set forth in the body of the claims. The fact that the language "co-curable" represents a positive claim feature in this regard is indicated by the attached listing of 39 US patents identified in the US PTO's searchable patent database (@ www.uspto.gov), which all recite "co-curable" or its variant "cocurable" in at least one claim. Further, a copy of the claims section of US patent 6,127,447 also is appended, which includes a Claim 25 in which "co-curable" language is explicitly used to characterize a component of a radiation curable coating composition. Although the file histories of these 39 patents have not been reviewed per se to determine whether the "co-curable" language was afforded patentable weight or not, the widespread and historical usage of that language in claims before the US Patent Office at least suggests that the language has been given such dignity in examinations before the Patent Office in the past.

Consequently, even assuming the Hutchison case were relevant, a proposition which Applicants respectfully disagree with, it does not represent controlling authority in the current application at issue, as it is factually distinguishable from the facts of the present application.

Moreover, based on Applicants' own legal research, the Hutchison case has been overruled, at least implicitly, for all intents and purposes by way of the more recent case authority of In re Venezia, 189 USPQ 149 (CCPA 1976). A courtesy copy of the Venezia case authority is appended for the Examiner's reference.

In the Venezia case, the CCPA (including a panel of judges including Chief Judge Markey and Judge Rich) reversed the US PTO Board of Appeals. In Venezia, the PTO Board of appeals had affirmed an Examiner's rejection of claims directed to a splice connector kit characterized by way of various components thereof that were recited as being "capable of being assembled" or "adapted to be" structurally or functionally interrelated with other recited components, as well as recitations of features having certain interrelationships "when", "then" and "whereby" certain events existed or occurred.

However, the CCPA reversed the Board of Appeals as it determined that the *"... claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. However, this is not to say that there is anything futuristic or conditional in the 'kit' of parts itself"* (189 USPQ at 151).

Again, the CCPA in Venezia explicitly ruled that such "adapted to" language, and the like, imparted a "structural limitation" to the claim, and the CCPA also stated that:
" ... we find nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly" (189 USPQ at 152). The CCPA

did not stop there either. The CCPA also ruled that arguably "conditional" language of certain features *"being displaced ... when"* nonetheless *"... serves to precisely define present structural attributes of interrelated component parts of the 'kit', such that a later assembly of the "kit" of parts may be effected"* (189 USPQ at 152).

Although the rejections under appeal in Venezia had been styled and made under 35 USC §§ 112 and 101, and not §§ 102 or 103 per se, Applicants submit that the case nonetheless is controlling authority here because the real issue is identical:

whether "adapted to" or "capable of", and the like claim language, concerning an intrinsic capability, function or structure of a recited feature, especially where it is made in reference to another claimed feature, is a positive limitation deserving patentable weight?

The Court in Venezia unequivocally answered this above question in the affirmative.

From the above and Applicants' previous arguments of record, it is apparent that the differences between the present claim 1 and Callahan '705 are substantial in nature and numerous in number. The dependent claims 8-11 distinguish Callahan '705 for at least the same reasons as their parent claim. From the foregoing discussion, it also is apparent why the parent application hereto, serial no. 08/988,215, was deemed to be patentability over Callahan's patent no. 5,494,180, which is the divisional of Callahan '705.

In sum, Callahan '705 does not identically disclose the present claimed invention. Therefore, Callahan '705 does not anticipate the present claimed invention, and this rejection

should be withdrawn.

At pages 3-4, paragraph 21, of the Office Action, claim 1 has been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 4,321,404 to Williams et al.

According to the final Office Action (p. 4), the "co-curable" recitation in claim 1 has been disregarded and not accorded patentable weight for the same reasons set out in paragraph 20 of the final Office Action.

In response, Applicants submit that the "co-curable" claim language cannot be ignored for the reasons set forth above in connection with the response to the rejection based on Callahan '705. Reference is made thereto. The patentable significance of the "co-curable" recitations in the claims has previously been fully explained in the record by Applicants (see Paper No. 4 of 8/17/00), and attention is kindly directed thereto to avoid creating undue redundancies in the record.

In view of the above, Williams et al. does not identically disclose the present claimed invention. Therefore, Williams et al. does not anticipate the present claimed invention, and this rejection should be withdrawn.

At page 4, paragraph 22, of the final Office Action, claims 1, 2 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,403,422 to Kawai et al.

According to the final Office Action (p. 4), the "co-curable" recitation in claim 1 has been disregarded and not accorded patentable weight for the same reasons set out in

paragraph 20 of the final Office Action.

In response, Applicants again submit that the "co-curable" claim language cannot be ignored for the reasons set forth above in connection with the response to the rejection based on Callahan '705. Reference is made thereto. The patentable significance of the "co-curable" recitations in the claims has previously been fully explained in the record by Applicants (see Paper No. 4 of 8/17/00), and attention is kindly directed thereto to avoid creating undue redundancies in the record.

In view of the above, Kawai et al. does not identically disclose the present claimed invention. Therefore, Kawai et al. does not anticipate the present claimed invention, and this rejection should be withdrawn.

At pages 4-5, paragraph 23, of the final Office Action, claims 3, 5-7, and 21-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawai et al. in view of U.S. Pat. No. 5,102,727 to Pittman et al.

According to the final Office Action (pp. 4-5), the "co-curable" recitation in claim 1 has been disregarded and not accorded patentable weight for the same reasons set out in paragraph 20 of the final Office Action.

Applicants respectfully submit that the Examiner's position in that regard is untenable for reasons explained above, and reference is made thereto.

In view of the above, the proposed combination of Kawai et al. and Pittman et al. does not defeat the patentability of the present invention, and, accordingly, this rejection should be withdrawn.

At page 5, paragraph 24, of the final Office Action, claims 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawai et al. in view of U.S. Pat. No. 5,185,381 to Ruffoni and U.S. Pat. No. 5,714,526 to Whyzmuzis.

According to the final Office Action (p. 5), the "co-curable" recitation in claim 1 has been disregarded and not accorded patentable weight for the same reasons set out in paragraph 20 of the final Office Action.

Applicants respectfully submit that the Examiner's position in that regard is untenable for reasons explained above, and reference is made thereto.

In view of the above, the proposed combination of Kawai et al., Ruffoni, and Whyzmuzis does not defeat the patentability of the present invention, and, accordingly, this rejection should be withdrawn.

Should no other rejections or objections remain outstanding, Applicants submit that this present application is in condition for allowance upon entry of the above amendment, and earnestly request notification of same.

If the Examiner believes that a teleconference would be useful in advancing the prosecution of this application, the

official is hereby invited to telephone undersigned counsel to
arrange for such a conference.

Respectfully submitted,
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